

REMARKS

I. Status of the Claims and General Remarks

A. Status of the Claims

Claims 1-4, 6-23, and 27-72 are currently pending. Claims 53-72 are withdrawn from consideration by the Examiner as being drawn to a non-elected invention.

Claims 1 and 27 are amended herein to remove graphite from the claimed list of particulate materials. Support for these amendments may be found in the as-filed specification and claims, for example, original claim 27 and paragraphs [067], [071], and [083] of the as-filed specification. Accordingly, Applicants respectfully submit that the above amendments raise no issue of new matter.

B. General Remarks

In the Office Action, the Examiner withdraws the prior 35 U.S.C. § 103(a) rejection in view of PCT Patent Publication No. WO 97/35457 ("Tungare"). See Office Action, page 2. The Examiner also indicates that claims 28-31 are allowable but objected to as being dependent upon a rejected base claim. See *id.* at 3.

In response, Applicants respectfully thank the Examiner for withdrawing the prior § 103(a) rejection and for the indication of allowable subject matter. However, Applicants maintain that all of the pending claims are allowable for at least the following reasons.

II. Response to Claim Rejection

The Examiner rejects pending claims 1-4, 6-23, 27, and 32-52 under § 103(a) as being unpatentable over U.S. Patent No. 4,316,930 ("Stengle."). See *id.* at 2-3. As the basis of the present § 103(a) rejection, the Examiner asserts that Stengle discloses each and every element of claims 1-4, 6-23, 27, and 32-52, except for the claimed particle size. See *id.* Nonetheless, the Examiner finds these claims unpatentable because,

where the only difference between the prior art and the claims. . . [is] a recitation of relative dimensions. . . and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device. . . [is] not patent[ably] distinct from the prior art device.

Id. at 3.

Applicants respectfully disagree with the Examiner's position, as it is based upon a misinterpretation and misapplication of 35 U.S.C. § 103(a) and the relevant case law. See M.P.E.P. § 2143 (explaining the burdens an Examiner must meet to establish a prima facie case of obviousness under 35 U.S.C. §103(a)); *In re Rose*, 220 F.2d 459, 461, 463 (C.C.P.A. 1955) (finding that claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" were not patentable over prior art lumber packages which could be lifted by hand because limitations relating to size were not sufficient to distinguish over prior art); *In re Rinehart*, 531 F.2d 1048, 1053 (C.C.P.A. 1976) ("[M]ere scaling up of a prior art process . . . would not establish patentability"); *Gardner v. TEC Sys., Inc.*, 725 F.2d 1338, 1345 (Fed. Cir. 1984) (stating that a claimed device is not patentably distinct from prior art that differs only in terms of relative dimensions).

In particular, the Examiner has not established *why* one of ordinary skill in the art would modify Stengle -- which discloses a glass fiber coated with an organopolysiloxane coating containing 44-70 μm graphite particles -- so as to incorporate particles having an average dimension ranging from 10nm to 10 μm , as recited in independent claim 1. See, for example, Stengle, column 6, lines 14-17 (indicating that the disclosed graphite particles have a diameter ranging from 44 to 70 μm); compare to claim 1 ("wherein the particles have an average dimension ranging from 10 nm to 10 μm . . .").

As to the relevant case law (i.e., *In re Rose*; *In re Rinehart*; *Gardner*), the Examiner has not explained how these cases (which are drawn to the patentability (or lack thereof) imparted by a scale reduction in the size of an *entire device*) apply to the issue in the present case (which relates to the use of a smaller particles, i.e., a smaller *component*, of a device). Nor has the Examiner explained *why* one of ordinary skill would expect Stengle's device to function in the same manner, despite being modified so as to contain particles having the claimed average dimension. See Office Action, page 3. This is particularly noteworthy, given that particle size is known to have a dramatic impact on the solid solubility of particles in a binder, and the fact that the present specification indicates that modification of the dimension of the claimed particles has an impact on the properties of the resultant article. See *specification*, pages 28-30, paragraphs [091]-[097]

Nonetheless, to even more clearly distinguish the claimed invention from Stengle, Applicants have amended claims 1 and 27 so as to remove graphite from the claimed list of particulate materials. Stengle does not teach or even suggest filler materials other than graphite, and thus cannot render obvious the present claims.

For at least the foregoing reasons, Applicants respectfully submit that the § 103(a) rejection of claims 1-4, 6-23, 27, and 32-52 as unpatentable over Stengle is improper, and should be withdrawn.

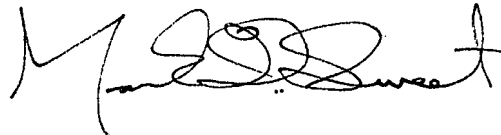
CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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